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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,601	10/16/2001	Brian R. Genge	16139/09015	5106

7590 10/31/2003

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EXAMINER

MARCANTONI, PAUL D

ART UNIT

PAPER NUMBER

1755

DATE MAILED: 10/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/978,601

Applicant(s)

Genge et al.

Examiner

Paul Marcatoni

Group Art Unit

1755

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 9/15/03.
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-15, 18, 20-24, 26-56, 58, 60, + 62-75 is/are pending in the application.
- Of the above claim(s) 34-55 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-15, 18, 20-24, 26-33, 56, 58, 60, + 62-75 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_.

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit: 1755

Applicant's arguments filed 9/15/03 have been fully considered but they are not persuasive.

The applicants amendment and submission of new claims 62-75 necessitated the following new grounds of rejection as well as new matter rejection.

Rejection:

Claims 1-15, 18, 20-24, 26-33, 56, 58, 60 and 62-75 are rejected under 35 U.S.C. 102(a and b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ying et al. '591.

Ying et al. would appear to teach nanoparticles of tricalcium phosphate that can be used for cement thus anticipating the instant invention. Even if not anticipated, overlapping ranges of amounts would have been prima facie obvious to one of ordinary skill in the art.

New Matter:

Claims 1-33 are rejected under 35 USC 112 first paragraph and 35 USC 132 as the specification as originally filed does not provide support for the invention as is now claimed.

The applicants added limitations in independent claims 1 15, 28 or any other claims where it appears is new matter. There would appear to be no support from applicants' specification for "sulfate salt" alone. The specification and the examples even all require that it be ---sodium sulfate--- because there is no other teaching of any other sulfate salt other than sodium sulfate. Insertion of --sodium sulfate--instead of sulfate salt would resolve this issue for all these claims.

Response:

The applicants argue that Ying would not be expected to form cementitious Material. In rebuttal, Ying would appear to teach that his composition can be used to make cement (refer to col.10, lines 30-35, for example) contrary to applicants' assertions. However, *Ying does not teach the presence of sodium sulfate and the applicants' addition of this limitation to all independent claims would make their claims allowable over Ying since it would appear Ying does not teach sodium sulfate.* This would also include new claims 62-75 as new independent claim 62 has no limitation with respect to sodium sulfate and it needs to be in this claim as well if the claims in their entirety would be allowed. Applicant are also reminded to actually cancel all non-elected claims or withdrawn claims should they decide to follow the examiner's suggestion.

The applicants also argue that Ying does not teach making a cement with a compressive strength greater than 65 Mpa. Then again, Ying does teach he makes a cement and applicants have not provided any experimental evidence other than their own assertion that Ying could not attain a greater than 65 Mpa cement strength. Absent any evidence experimental or otherwise, the applicants' assertion regarding strength and the actual formation of cement is not convincing. Again, the reference makes it clear that it can form cement. Again, if applicants simply insert sodium sulfate into independent claims including new claim 62 this would render this dispute <sup>moot</sup> ~~mute~~ because it would not appear that Ying teaches sodium sulfate in his disclosure.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is (703)-308-1196. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on (703) 308-3823. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9310 for regular communications and (703)-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

  
**PAUL MARCANTONI**  
**PRIMARY EXAMINER**  
**GROUP 1700**